PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Travis J. Parry et al.	Confirmation No.: 8613
Application No.: 10/625,241	Examiner: MILLA, Mark R.
Filing Date: July 22, 2003	Group Art Unit: 2625

Title: **Methods and Systems for Providing Web Content to a Printing Device**

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on ___August 18, 2008___ .

☒ The fee for filing this Appeal Brief is $540.00 (37 CFR 41.20).

☐ No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month $130	☐ 2nd Month $490	☐ 3rd Month $1110	☐ 4th Month $1730

☐ The extension fee has already been filed in this application.

☒(b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of ___$ 540___ . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

Travis J. Parry et al.

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APPEAL BRIEF

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Sir:

This is an Appeal Brief under Rule 41.37 appealing the decision of the Primary

Examiner dated June 24, 2008 (the "final Office Action" or "Action"). Each of the topics

required by Rule 41.37 is presented herewith and is labeled appropriately.

I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no appeals or interferences related to the present application of which the

Appellant is aware.

III. Status of Claims

Under the imposition of a previous Restriction Requirement, claims 7-26 and 38-52 were withdrawn from consideration and cancelled without prejudice or disclaimer. Thus, claims 1-6, 27-37, and 53-58 are pending in the application and stand finally rejected. Accordingly, Appellant appeals from the final rejection of claims 1-6, 27-37, and 53-58, which claims are presented in the Appendix.

IV. Status of Amendments

No amendments have been filed subsequent to the final Office Action of June 24, 2008, from which Appellant takes this appeal.

V. Summary of Claimed Subject Matter

Appellant's independent claims recite the following subject matter.

Claim 1 recites:

A method of providing web content (103) to a printing device (130), said method comprising attaching (201) a memory module (110) storing said web content (103) (*Appellant's specification, paragraph 0019*) to a printing device consumable (120) (*Appellant's specification, paragraph 0037*);

wherein said web content (103) comprises content that is included in a web page that is served up by said printing device (130) using an embedded web server (135) (*Appellant's specification, paragraph 0040*).

Claim 32 recites:

A consumable for use with a printing device, said consumable comprising:

a printing device consumable (120) (*Appellant's specification, paragraph 0023*);

a memory module (110) attached to said printing device consumable (120) (*Appellant's specification, paragraph 0037*); and

web content (103) stored on said memory module (110) (*Appellant's specification, paragraph 0019*), wherein said web content (103) is included in a web page served up by said printing device (130) using an embedded web server (135) (*Appellant's specification, paragraph 0040*).

Claim 53 recites:

A method of providing web content for a printing device, said method comprising:

storing (200) web content (103) on a memory module (110) attached to a printing device consumable (120) (*Appellant's specification, paragraph 0037*);

uploading (204) said web content (103) from said memory module (110) to said printing device (130) when said consumable (120) is installed in said printing device (130) (*Appellant's specification, paragraph 0038*); and

serving up a web page (205) with said printing device (130) using an embedded web server (135) (*Appellant's specification, paragraph 0040*), said web page comprising said web content (103) provided to said printing device (130) with said memory module (110) attached to said printing device consumable (120) (*Appellant's specification, paragraph 0040*).

VI. Grounds of Rejection to be Reviewed on Appeal

The final Office Action raised the following grounds of rejection.

(1)   Claims 1-6, 32-34, 36-37, and 53 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of U.S. Patent No. 6,332,062 to Phillips ("Phillips") and U.S. Patent App. Pub. No. 2003/0234957 to Ohara ("Ohara").

(2)   Claims 27-28 and 54-55 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Phillips, Ohara, and U.S. Patent No. 6,532,351 to Richards ("Richards").

(3)   Claims 29-31 and 56-58 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Phillips, Ohara, Richards, and U.S. Patent App. Pub. No. 2005/0240518 to Ishizuka ("Ishizuka").

(4)   Claim 35 was rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Phillips, Ohara, and Richards.

According, Appellant hereby requests review of each of these grounds of rejection in the present appeal.

VII. Argument

(1)   Claims 1-6, 32-34, 36-37, and 53 are patentable over Phillips and Ohara.

Claim 1:

Independent claim 1 recites:

>   A method of providing web content to a printing device, said method
> comprising attaching a memory module storing said web content to a printing device
> consumable;
>   *wherein said web content comprises content that is included in a web page*
> *that is served up by said printing device using an embedded web server.*

(Emphasis added).

In contrast, the combination of Phillips and Ohara does not teach or suggest a method of

providing "web content" to a printing device using a memory module attached to a print

consumable.

Claim 1 specifically recites and defines "web content" as "content that is included in a

web page that is served up by said printing device using an embedded print server." Thus, the

claimed "web content," as recited within claim 1, is originating from "a memory module"

attached to "a printing device consumable."   The final Office Action improperly ignores this

subject matter recited in claim 1.

The recited origin of the "web content," i.e., from a memory module attached to a

printing device consumable, provides the significant advantage of updating web content

served up by a printing device simply by inserting new print consumables to the printing

device. This subject matter is entirely outside the scope and content of the cited prior art.

Phillips does not teach or suggest the "web content" as recited by claim 1. The final

Office Action erroneously asserts that "a URL" taught by Phillips (Phillips, col. 2, lines 8-18)

constitutes the claimed "web content." (Action, p. 3). However, the URL taught by Phillips is

simply an address for accessing a webpage, and is not web content as expressly defined in

claim 1. Specifically, the neither the URL nor any other content taught by Phillips can be "web content" recited in claim 1 because no such content taught by Phillips is included in a "webpage that is served up by said printing device using an embedded web server" as recited in claim 1. Accordingly, Phillips does not teach or suggest providing "web content" to a printing device using a memory module attached to a print consumable within the meaning of claim 1.

The Examiner concedes that Phillips does not disclose "wherein said web content comprises content that is included in a web page that is served up by said printing device using an embedded web server." (Action, p. 3) Consequently, the Examiner cites Ohara. However, Ohara does not remedy the shortcomings of Phillips. Specifically, Ohara does not teach "web content" as expressly defined in claim 1 that is originating from "a memory module" attached to "a printing device consumable." In contrast, Ohara teaches a system in which information, in the form of a print job, is received by a printer over a network connection. (Ohara, Fig. 1; paragraph 0031).

The transfer of a print job over a network connection, as taught by Ohara, does not teach or suggest the claimed method. Specifically, the transfer of print job data over a local area connection cannot be reasonably construed to teach or suggest web content originating from memory module attached to a printing device consumable. Consequently, because it does not originated in a memory module attached to a printing device consumable, any teachings regarding the print job of Ohara are irrelevant to the claimed "web content." In other words, the print job of Ohara is not "web content" as expressly defined in claim 1, and the transmission of a print job over a network has absolutely nothing to do with "attaching a memory module storing said web content to a printing device consumable." Again, Ohara does not remedy any of the noted shortcomings of the primary reference to Phillips.

Consequently, the combination of Phillips and Ohara does not teach or suggest providing

"web content" to a printing device using a "memory module attached to a print consumable"

as recited in claim 1.

Moreover, the features and advantages of Appellant's claimed subject matter were

not available in the prior art. A significant advantage taught by the Appellant, namely

updating web content served by a printing device simply by inserting new print consumables

to the printing device, is not taught or disclosed by the prior art.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a

rejection under § 103, the scope and content of the prior art must first be determined,

followed by an assessment of the differences between the prior art and the claim at issue in

view of the ordinary skill in the art. In the present case, the scope and content of the prior art,

as evidenced by Phillips and Ohara, does not include the subject matter of claim 1,

particularly, providing "web content" to a printing device using a "memory module attached

to a print consumable."

The differences between the cited prior art and the claimed subject matter are

significant because the claimed subject matter provides features and advantages that were not

available in the cited prior art, namely periodically updating a web page served by a printer by

simply inserting new print consumables into the printer. (*See* Appellant's specification,

paragraphs 0022-0024, 0038). Consequently, the cited prior art will not support a rejection of

claim 1 and its dependent claims under 35 U.S.C. § 103 and *Graham*.

Claim 32:

Independent claim 32 recites:

A consumable for use with a printing device, said consumable comprising:

> a printing device consumable;
> a memory module attached to said printing device consumable; and
> *web content stored on said memory module, wherein said web content is*
> *included in a web page served up by said printing device using an embedded web*
> *server.*

(Emphasis added).

As amply demonstrated above, the combination of Phillips and Ohara does not teach or suggest a consumable which stores web content on memory module attached to a print consumable, where the "web content" is expressly defined as being "included in a web page served up by said printing device using an embedded web server."

As demonstrated above, the final Office Action erroneously asserts that "a URL" taught by Phillips (Phillips, col. 2, lines 8-18) constitutes the claimed web content. (Action, p. 3, 4). However, the URL taught by Phillips simply provides an address for accessing a webpage and is not included in a web page served up by the printing device using an embedded web server as is the claimed web content. Accordingly, Phillips does not teach or suggest the claimed consumable that provides web content within the meaning of claim 32.

The Examiner concedes that Phillips does not disclose "wherein said web content comprises content that is included in a web page that is served up by said printing device using an embedded web server." (Action, p. 3) Consequently, the Examiner cites Ohara. However, as amply demonstrated above, Ohara does not remedy the shortcomings of Phillips because Ohara also does not teach or suggest "web content" stored on memory module attached to a printing device consumable within the meaning of claim 32.

Rather, Ohara merely teaches the transfer of print job data over a local area connection to a printer. (Ohara, Fig. 1; paragraph 0030-0031). The transfer of print job data over a local area connection cannot be reasonably construed to teach or suggest web content originating from memory module attached to a printing device consumable. Consequently, because it

does not originated in a memory module attached to a printing device consumable, any

teachings regarding the print job of Ohara are irrelevant to the claimed "web content."

Therefore, the combination of Phillips and Ohara does not teach or suggest a

consumable which stores web content on memory module attached to a print consumable.

Moreover, a significant advantage taught by the Appellant, namely updating web content

served by a printing device by simply inserting print consumables to the printing device, is

not taught or disclosed by the prior art.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a

rejection under § 103, the scope and content of the prior art must first be determined,

followed by an assessment of the differences between the prior art and the claim at issue in

view of the ordinary skill in the art. In the present case, the scope and content of the prior art,

as evidenced by, Phillips and Ohara, clearly did not include the subject matter of claim 32.

Consequently, the cited prior art will not support a rejection of claim 32 and its dependent

claims under 35 U.S.C. § 103 and *Graham*.

<u>Claim 53</u>:

Independent claim 53 recites:

> A method of providing web content for a printing device, said method
> comprising:
> storing web content on a memory module attached to a printing device
> consumable;
> uploading said web content from said memory module to said printing device
> when said consumable is installed in said printing device; and
> *serving up a web page with said printing device using an embedded web*
> *server, said web page comprising said web content provided to said printing device*
> *with said memory module attached to said printing device consumable.*

(Emphasis added).

As amply demonstrated above, the combination of Phillips and Ohara does not teach or suggest the claimed method of providing web content for a printing device. Claim 53 specifically recites "uploading web content from said memory module from said memory module" and "serving up a web page with said printing device using an embedded web server, said web page comprising said web content." Importantly, the claimed web content is recited within claim 53 as being stored on a memory module" attached to "a printing device consumable" and then later uploaded to the printing device. The origin of the "web content" from a memory module attached to a printing device consumable provides the significant advantage of updating web content served by a printing device by simply inserting new print consumables to the printing device.

As demonstrated above, neither Phillips nor Ohara, whether taken separately or in combination, teach or suggest a method for providing web content for a printing device by "uploading said web content from said memory module to said printing device" and "serving up a web page with said printing device using an embedded web server, said web page comprising said web content." (Claim 53).

As discussed above, Phillips does not teach "web content" and therefore cannot teach storing "web content" on a memory module attached to a printing device consumable. Additionally, the Examiner concedes that Phillips does not disclose "serving up a web page with said printing device using an embedded web server, said web page comprising said web content."

The Examiner then cites Ohara to remedy the deficiencies of Phillips. However, Ohara cannot remedy the deficiencies of Phillips because Ohara does not teach "uploading web content from said memory module from said memory module" or "serving up a web page with said printing device using an embedded web server, said web page comprising said

web content." First, Ohara does not teach "uploading said web content from said memory module to said printing device." As discussed above, the transfer of print job data over a local area connection as taught by Ohara (Ohara, Fig. 1; paragraph 0030-0031) cannot be reasonably construed to teach or suggest uploading said web content from said memory module to said printing device. Second, Ohara does not teach or suggest "serving up a web page with said printing device using an embedded web server, said web page comprising said web content" because the print job data received the printer in Ohara not "web content." The print job data cannot be web content because it is not configured to be displayed on a webpage and is never accessed by an embedded web server. (Ohara, Fig. 1, Fig. 4, Fig. 6; paragraphs 0030, 0031, 0057-0063).

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, the scope and content of the prior art, as evidenced by Phillips and Ohara, does not include the subject matter of claim 53. Specifically, the combination of Phillips and Ohara does not teach a method for providing web content for a printing device by "uploading said web content from said memory module to said printing device" and "serving up a web page with said printing device using an embedded web server, said web page comprising said web content."

The differences between the cited prior art and the claimed subject matter are significant because the claimed subject matter provides features and advantages with regard to periodically updating a web page served by a printer by insertion of print consumables into the printer. (*See* Appellant's specification, paragraphs 0022-0024, 0038). Consequently, the

cited prior art will not support a rejection of claim 53 and its dependent claims under 35

U.S.C. § 103 and *Graham*.

Claim 4:

Claim 4 recites "further comprising uploading a web content interface from said

memory module to a memory of said printing device." The final Office Action erroneously

asserts that "a message look up table that contains user messages" taught by Phillips (Phillips,

col. 3, line 66- col. 4, line 5) is equivalent to the "web content interface" recited by claim 4.

Appellant respectfully disagrees.

The Appelllant's specification teaches that:

> The web content interface (104) can be uploaded by a printer or printing
> device and *used to access the web content (103) that remains on the memory module*
> (110). The web content interface (104) is stored *as computer-readable instructions*
> that can be uploaded and executed by a host printer or printing device. The web
> content interface (104) may be written according to customer specifications.

(Appellant's specification, paragraph 22) (emphasis added).

In contrast, the "message look up table" taught by Phillips is simply a data structure

which contains user messages. A transfer of the "message look up table" includes moving the

user messages contained in the "message look up table." (Phillips, col. 3, line 66- col. 4, line

5). Nowhere does Phillips teach that the "message look up table" comprises computer

readable instructions that are "used to access web content that remains on the memory

module." Consequently, Phillips does not teach or suggest the web content interface recited

in claim 4. For at least these reasons, the rejection of claim 4 and its dependent claim should

not be sustained.

Claim 36:

Claim 36 recites "further comprising a wired interface for said memory module for interfacing and communicating with a printing device." The final Office Action erroneously asserts that "conventional semiconductor memory" taught by Phillips (col. 3 lines 36-38) discloses the claimed "wired interface." It is clear that "conventional semiconductor memory" does not teach or imply any specific interface for transferring data between a memory module and a printing device. For at least these reasons, the rejection of claim 36 should not be sustained.

2)   Claims 27-28 and 54-55 are patentable over Phillips, Ohara, and Richards.

This rejection should not be sustained for at least the same reasons given above in favor of the patentability of the independent claims.

Additionally, claims 27 and 54 recite "receiving data specifying desired web content from a purchaser of a printing device consumable." The final Office Action erroneously asserts that Richards teaches "receiving data specifying desired web content from a purchaser of a printing device consumable." (Action, p. 7). However, the portions of Richards cited by the Action disclose a unit monitor associated with replaceable module. (Richards, col. 4, lines 4-10). Although Richards goes to great length to recite various types of data that can be stored in the unit monitor (Richards, col. 4, line 4- col. 5, line 32), Richards neither discloses or suggests "web content" or any type of data that is received from "a purchaser of a printing device consumable." Consequently, the final Office Action has failed to actually identify the claimed subject matter in the teachings of the prior art.

Receiving data specifying desired web content from a purchaser of a printing device consumable provides the benefit of allowing the purchaser to specify web content customized

for the purchaser's organization or needs. For example, the web content specified by the purchaser could be a customized web content interface that is written according to the customer specifications. (Appellant's specification, paragraph 0022).

Thus, for at least the additional reasons given above, the combination of Phillips, Ohara, and Richards does not teach or suggest the claimed subject matter of independent claims 27 and 54. Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. In the present case, as amply demonstrated above, the scope and content of the prior art, as evidenced by Phillips, Ohara, and Richards, did not include the subject matter of Applicant's claims 27 and 54. For at least these reasons, the rejection of claims 27 and 54 should not be sustained.

(3)   Claims 29-31 and 56-58 are patentable over Phillips, Ohara, Richards, and Ishizuka.

This rejection should not be sustained for at least the same reasons given above in favor of the patentability of the independent claims.

Additionally, claims 29 and 56 recite "receiving data specifying said web content from a purchaser comprises receiving said web content through a terminal at a consumables sales facility." The Action concedes that Phillips, Ohara, and Richards to not teach the recited subject matter of claim 29 and 56.

Consequently the Action cites Ishizuka as disclosing "receiving data specifying said web content from a purchaser comprises receiving said web content through a terminal at a consumables sales facility." However, the portions of Ishizuka cited by the examiner, fail to

teach or suggest "receiving web content" from a purchaser. (Ishizuka, paragraphs 0020, 0021).

Consequently, it is impossible for Ishizuka, to teach "receiving data specifying said web content from a purchaser comprises receiving said web content through a terminal at a consumables sales facility" as recited in claims 29 and 56. For at least these additional reasons, the rejection of claims 29 and 56 should not be sustained.

(4)   Claim 35 is patentable over Phillips, Ohara and Richards.

This rejection should not be sustained for at least the same reasons given above in favor of the patentability of the independent claims.

In view of the foregoing, it is submitted that the final rejection of the pending claims is improper and should not be sustained. Therefore, a reversal of the Rejection of June 24, 2008 is respectfully requested.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1.   (previously presented) A method of providing web content to a printing device, said method comprising attaching a memory module storing said web content to a printing device consumable;

wherein said web content comprises content that is included in a web page that is served up by said printing device using an embedded web server.

2.   (original)   The method of claim 1, further comprising:

installing said printing device consumable in said printing device; and

interfacing said printing device and said memory module.

3.   (original)   The method of claim 2, further comprising uploading said web content from said memory module to a memory of said printing device.

4.   (original)   The method of claim 2, further comprising uploading a web content interface from said memory module to a memory of said printing device.

5.   (previously presented) The method of claim 4, further comprising executing said web content interface with a controller of said printing device.

6.   (original)   The method of claim 5, further comprising using said web content on said memory module through said web content interface.

7-26.   (cancelled)

27.   (previously presented)The method of claim 1, further comprising:

receiving data specifying desired web content from a purchaser of a printing device consumable; and

storing said web content on said memory module attached to said printing device consumable.

28.   (original)   The method of claim 27, further comprising providing said printing device consumable with said memory module to said purchaser.

29.   (original)   The method of claim 27, wherein said receiving data specifying said web content from a purchaser comprises receiving said web content through a terminal at a consumables sales facility.

30.   (original)   The method of claim 27, wherein said receiving data specifying said web content from a purchaser comprises receiving said web content from said purchaser through a computer network.

31.   (original)   The method of claim 30, wherein said computer network comprises the Internet.

32.   (previously presented)A consumable for use with a printing device, said consumable comprising:

a printing device consumable;

a memory module attached to said printing device consumable; and

web content stored on said memory module, wherein said web content is included in a web page served up by said printing device using an embedded web server.

33.   (original)   The consumable of claim 32, further comprising a wireless interface for said memory module for interfacing and communicating with a printing device.

34.   (original)   The consumable of claim 33, wherein said wireless interface comprises a radio frequency interface.

35.   (original)   The consumable of claim 33, wherein said wireless interface comprises an infrared interface.

36.   (original)   The consumable of claim 32, further comprising a wired interface for said memory module for interfacing and communicating with a printing device.

37.   (original)   The consumable of claim 32, further comprising a web content interface stored on said memory module which, when uploaded to a printing device, allows access and use of said web content on said memory module.

38-52. (cancelled)

53.   (previously presented)A method of providing web content for a printing device, said method comprising:

storing web content on a memory module attached to a printing device consumable;

uploading said web content from said memory module to said printing device when said consumable is installed in said printing device; and

serving up a web page with said printing device using an embedded web server, said web page comprising said web content provided to said printing device with said memory module attached to said printing device consumable.

54.   (previously presented)The method of claim 53, further comprising:

receiving data specifying desired web content from a purchaser of a printing device consumable;

storing said purchaser-specified web content on said memory module attached to said printing device consumable.

55.   (previously presented)The method of claim 54, further comprising providing said printing device consumable with said memory module to said purchaser.

56.   (previously presented)The method of claim 54, wherein said receiving data specifying said web content from a purchaser comprises receiving said web content through a terminal at a consumables sales facility.

57.   (previously presented) The method of claim 54, wherein said receiving data specifying said web content from a purchaser comprises receiving said web content from said purchaser through a computer network.

58.   (previously presented) The method of claim 57, wherein said computer network comprises the Internet.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None